

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

Claims 10, 25, 48, 54 and 61 are currently being amended.

This amendment adds, changes and/or deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

After amending the claims as set forth above, claims 1-20 and 22-61 remain pending in this application.

Rejections of claims 18-20 and 46

Claims 18-20 and 46 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 5,315,508 to Bain et al. (hereinafter “Bain”) in view of U.S. Patent No. 4,802,218 to Wright et al. (hereinafter “Wright”). Applicant respectfully traverses this rejection for at least the following reasons.

As recited in pending claim 18, the packing at the distribution center includes “separating the parts ... such that the waybill part is located outside the package ..., but no other of said parts is located outside the package during shipment.” Claim 46 recites a similar feature.

Neither Bain nor Wright teaches or suggests at least this feature of the pending claims. In rejecting claim 18, while acknowledging that Bain fails to teach or suggest a waybill as recited in the claims, the Examiner cites various portions of Bain as allegedly disclosing that a “certain part” is located outside the package, but no other parts are located outside the package. Office Action dated October 13, 2011, page 3. Specifically, the Examiner cites Bain, col. 1, lines 5-18; col. 3, lines 1-36; col. 7, line 28 – col. 8, line 34; and col. 20, lines 34-67. Applicant addresses each of these sections individually.

Bain, col. 1, lines 5-18

Bain discloses the “Technical Field” of the invention and describes a system in which a user enters information when prompted. The system processes a purchase order and “verifies packing information against an electronically received purchase order and generates shipping labels” There is no teaching or suggestion in this section related to the positioning of parts during shipment.

Bain, col. 3, lines 1-36

In this cited portion, Bain discloses that a user may pack a container to fill a purchase order, entering information for each item being packed. The system then “automatically prints a shipping label in compliance with the requirements of the consignee” Again, there is nothing in this cited portion of Bain that relates to the positioning of parts during shipment. Specifically, there is no teaching or suggestion of “separating the parts ... such that the waybill part is located outside the package ..., but no other of said parts is located outside the package during shipment.”

Bain, col. 7, line 28 – col. 8, line 34

This cited portion of Bain relates to the operation of the system illustrated in Figure 1 of Bain. Bain discloses the use of stored data to process a purchase order. The processing results in the printing of a shipping label and a packing list label. There is no teaching or suggestion that a waybill (or the shipping label which the Examiner appears to equate to the waybill) is located outside the package, but no other parts (e.g., the packing list) is located outside the package.

To the contrary, this portion of Bain actually discloses that the packing list may be located outside the package. Specifically, Bain discloses:

“An example of a **packing list label** is depicted in FIG. 3. It is noted that the marking printer 40 is a printer that prints information on a web of record members such as tags, **labels** or the like that are **affixable to a container** such as a box or a skid to mark the container.” Bain, col. 8, lines 29-34 (emphasis added).

Thus, Bain discloses that a label, such as a packing list label, may be affixable to a container to mark the container. In other words, the packing list label may be on the outside of the container.

Bain, col. 20, lines 34-67

This cited portion of Bain discloses the entry of items in a pack list by a user into the system. There is no disclosure even of a printed label. Applicant believes the Examiner has misinterpreted the disclosure of “display data fields” in this portion of Bain to mean data that is visible on a printed label. In fact, this portion of Bain merely relates to data fields and information displayed on a monitor, such as the display 14 in Figure 1 of Bain. For example, Bain discloses “at block 430, the line item record processed at block 424 is marked as packed and at block 432 the display data fields for that line item are cleared from the **display 14**.” Bain, col. 20, lines 49-52 (emphasis added).

Thus, none of the cited portions of Bain teach or suggest the feature alleged by the Examiner. Further, as to the Examiner statement that “[i]t is recommended that the applicants consider the cited prior art reference as a ‘whole’ and not just sections/columns cited by the examiner,” Applicant respectfully notes that it is the Examiner’s burden to illustrate with precision where the cited references teaches or suggests the claimed features. Nevertheless, Applicant’s representative has performed a thorough review of the disclosure of Bain and finds no teaching or suggestion of the above-noted feature of pending claims 18 and 46.

Therefore, claims 18 and 46 are patentable. Further, claims 18 and 19 each depend from allowable claim 18 and are, therefore, patentable for at least that reason, as well as for additional patentable features when those claims are considered as a whole.

Rejections of claims 1-17, 22-45 and 47-61

Claims 1-17, 22-45 and 47-61 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Bain in view of Wright and further in view of U.S. Patent No. 6,208,980 to Kara (hereinafter “Kara”). Applicant respectfully traverses this rejection for at least the following reasons.

In accordance with the pending claims, a singular sheet is formatted to include a waybill area, at least one of a packing list or product code, and a customizable component area. Each of independent claims 1, 22, 25 30, 45, 47, 48 and 54-61 recites, or has been amended to recite, a singular sheet.

In rejecting claim 1, the Examiner argues that Bain discloses the singular sheet recited in the pending claims. Specifically, the Examiner points to Figure 2 and to various other portions of Bain. Applicant respectfully disagrees with the Examiner's interpretation of the disclosure of Bain as applied to the pending claims.

First, Figure 2 of Bain merely illustrates a shipping label. For example, in the description of the drawings, Bain discloses that "FIG. 2 is an illustration of a compliance shipping label printed by the system" Bain, col. 3, lines 44-45. There is no teaching or suggestion that the shipping label is on a singular sheet which includes any other components.

Second, the other portions of Bain cited by the Examiner merely disclose printing of various individual components. For example, Bain discloses the printing of a packing list, but fails to disclose that the packing list is printed on a singular sheet which includes any other components.

Thus, Bain fails to teach or suggest at least this feature of the pending claims. Further, neither Wright nor Kara cure this deficiency of Bain. Therefore, the Office Action fails to establish a *prima facie* case of obviousness.

Therefore, independent claims 1, 22, 25 30, 45, 47, 48 and 54-61 are patentable for at least the above-noted reasons. Further, claims 2-17, 23, 24, 26-29, 31-44 and 49-53 each depend from one of the allowable independent claims and are, therefore, patentable for at least that reason, as well as for additional patentable features when those claims are considered as a whole.

Conclusion

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment,

to Deposit Account No. 50-5302. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 50-5302. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 50-5302.

Respectfully submitted,

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